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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,926	01/29/2004	Baldomero M. Olivera	2314-273	2903
6449 7590 02/01/2007 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			EXAMINER KOSSON, ROSANNE	
			ART UNIT	PAPER NUMBER
			1652	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/01/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

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**Office Action Summary**

Application No.

10/765,926

Applicant(s)

OLIVERA ET AL.

Examiner

Rosanne Kosson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicants' election with traverse- traverse regarding examining a propeptide and its mature peptide together- of SEQ ID NO: 142 and SEQ ID NO: 143 (the propeptide and the mature peptide, respectively) in the response filed on December 6, 2006 is acknowledged. In reply, these two sequences will be searched and examined together. No claims have been amended, canceled or added. Only claims 1(c) and 5 read on the elected invention, as SEQ ID NOS: 142 and 143 are listed in Table 1 and not in Table 2. Claims 2-4 and 6-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions, there being no allowable generic or linking claim. Accordingly, claims 1 and 5 are examined on the merits herewith to the extent that these claims read on the elected invention, SEQ ID NO: 142 or SEQ ID NO: 143.

In their remarks, although made without traverse, Applicants assert that all of their many inventions should be searched and examined together because these multiple searches and examinations do not create an undue burden for Examiner, because each invention entails the same search. Applicants discuss each of the many requirements that must be satisfied for patentability and assert that each of their inventions fulfills each of these requirements in the same way.

In reply, it was explained in thorough detail in the previous Office action that each invention requires a separate and distinct search and examination that do not cover any other invention and that each invention must be examined separately in the literature and sequence databases. As for the many requirements for patentability under 35 USC §§101, 102, 103 and 112, first and second paragraphs, as well as statutory and obviousness-type double patenting,

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these are determinations for the Office to make, not Applicants. Examining each invention with respect to each of these requirements most certainly is an enormous burden. Each examiner has an extremely small and ever diminishing amount of time to spend on each application, and filing many inventions together in one application is elective on Applicants' part. In view of the foregoing, the restriction requirement is maintained and is made final.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Olivera et al. ("Peptide neurotoxins from fish-hunting cone snails," Science 230:1338-1343, 1985) and by Colledge et al. ("Precursor structure of omega-conotoxin GVIA determined from a cDNA clone," Toxicon 30(9):1111-1116, 1992).

Olivera et al. disclose the mature polypeptide toxin of SEQ ID NO: 143 (see p. 1339, Table 2, GVIA). The polypeptide of Olivera et al. has 100% sequence identity to SEQ ID NO: 143, which is amino acids 46–72 of SEQ ID NO: 142.

Colledge et al. disclose both the mature polypeptide of SEQ ID NO: 143 and the propeptide of SEQ ID NO: 142 ( $\omega$ -conotoxin GVIA), the mature polypeptide being a fragment of the propeptide (see p. 1113, Fig. 2, and p. 1114, Fig. 3). The polypeptide of Colledge et al. has 100% sequence identity to SEQ ID NO: 142. See Result 1 from a search in the Uniprot database on January 19, 2007, an alignment of Applicants' SEQ ID NO: 143 with the sequence of Colledge et al., which contains the sequence of Olivera et al.

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Therefore, a holding of anticipation is required.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rosanne Kosson  
Examiner, Art Unit 1652

rk/2007-01-23

